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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,581	06/11/2001	Susumu Nakagawa	450100-03278	2762
20999 7590 12/14/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL.. NEW YORK, NY 10151				
EXAMINER SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
12/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/878,581

**Applicant(s)**

NAKAGAWA, SUSUMU

**Examiner**

JAMES SHELEHEDA

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22, 28-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 28-30 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SEA-3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/01/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (Hite) (5,774,170) (of record) in view of Zigmond et al. (Zigmond) (6,698,020) (Of record).

Regarding claims 21 and 29, Hite discloses that the claimed "program storage medium stored with an advertisement image providing program which is a program storage medium stored with an advertisement image providing program for providing an advertisement image", and corresponding advertisement image providing apparatus, is met as follows:

- The claimed "an advertisement image database for storing said advertisement image" is met by column 7, lines 52-64, which disclose storage servers for storing the programming and advertisements.

- The claimed "advertisement image selecting means for receiving via stream distribution selection information from an image content providing apparatus and for selecting said advertisement to be provided from said advertisement image database based upon said selection information" is met by column 7, lines 52-64

selecting said advertisement image to be provided from an advertisement image database" is met by column 7, lines 52-64, which disclose that the headend will match the subscriber CID code to an appropriate commercial to control switching commercials into the VOD stream.

- The claimed "advertisement image providing means having a function of providing via stream distribution said advertisement image selected by said advertisement image selecting means and generating an advertisement providing log constituting history information in providing said advertisement image" is met by column 7, lines 52-64, disclosing the switching of the desired commercial into the transmitted programming stream. Also, the Ad Administration Facility 100 contains Customer

Database 128, which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58].

- The claimed "advertisement database registering means for attaching an advertisement identifier to said advertisement image" is disclosed by column 3, line 39-60, which disclose that commercial Identifier codes are appended to the commercials prior to storage in the database,

While Hite discloses distributing ads to viewers for display, he fails to specifically disclose a maximum number of distribution times.

In an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Hite's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

5. Claims 1-16, 18-20, 22, 28, 30 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-el (WO 99/26415 A1) (of record) in view of Srinivasan et al. (Srinivasan) (US 2001/0023436 A1) (of record) and Zigmond.

As to claim 1, while Bar-el discloses an image content providing method of providing an image content via stream distribution from an image content providing apparatus to an image content reproducing apparatus (page 7, lines 2-19), said image content providing method comprising the steps of:

requesting, via the stream distribution, distribution of said image content, said request sent from said image content reproducing apparatus to said image content providing apparatus (page 7, lines 20-22);

transmitting, via stream distribution, said image content to said image content reproducing apparatus (Fig. 1; page 8, lines 4-18) and during transmission detecting a position of inserting an advertisement image in said image content at said image content providing apparatus (page 14, line 14-page 15, line 5);

requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image to said image content providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

selecting said advertisement image to be inserted into said image content (page 11, line 14-page 12, line 9) and transmitting thereof by stream distribution to said image content providing apparatus at said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

inserting said advertisement image transmitted to said image content providing apparatus at the position of inserting said advertisement image in said image content at said image content providing apparatus (page 14, line 24-page 16, line 21);

distributing, via stream distribution the inserted advertisement image from said image content providing apparatus to said image content reproducing apparatus (Fig. 1-2; page 7, line 11-page 8, line 18), he fails to specifically disclose restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as

taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 3, Bar-el, Srinivasan and Zigmond disclose wherein the position of said image content for inserting said advertisement image is detected based on advertisement inserting condition data having an advertisement image inserting position condition for designating the position of inserting said advertisement image and an advertisement image selecting condition for designating a category of said advertisement image capable of being inserted to said image content (column 14, lines 14-21 and column 11, lines 14-19).

As to claim 4, Bar-el, Srinivasan and Zigmond disclose wherein said advertisement inserting condition data includes an advertisement image reproducing condition for designating a maximum period of time for reproducing said advertisement image when said advertisement image is inserted to said image content (page 14, lines 14-21).



As to claim 5, Bar-el, Srinivasan and Zigmond disclose wherein when said advertisement image is requested to distribute at said image content providing apparatus, said advertisement inserting condition data is transmitted to said advertisement image providing apparatus (page 11, lines 9-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said advertisement inserting condition data (page 11, lines 9-19).

As to claim 6, Bar-el, Srinivasan and Zigmond disclose wherein when said image content is requested to distribute at said image content reproducing apparatus, viewer information of a viewer for utilizing said image content is transmitted to said image content providing apparatus (page 10, lines 3-20).

As to claim 7, Bar-el, Srinivasan and Zigmond disclose wherein when said advertisement image is requested to distribute at said image content providing apparatus, said viewer information is transmitted to said advertisement image providing apparatus (page 11, lines 6-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said viewer information (page 11, lines 6-19).

As to claim 8, Bar-el, Srinivasan and Zigmond disclose wherein said image content providing apparatus comprises:

a main image content distributing apparatus (Fig. 1-2); and  
a plurality of deputy image content distributing apparatus (page 7, lines 13-19);  
wherein said main image content distributing apparatus selects one of the deputy  
image content distributing apparatus from said plurality of deputy image content  
distributing apparatus by a request of distributing said image content from said image  
content reproducing apparatus and said selected deputy image content distributing  
apparatus distributes said image content to said image content reproducing apparatus  
(plurality of intermediate routers and nodes present in an Internet distribution system;  
page 7, lines 13-19 and page 10, line 23-page 11, line 5).

As to claim 9, Bar-el, Srinivasan and Zigmond disclose wherein said image  
content providing apparatus comprises:

a main image content distributing apparatus (Fig. 1-2); and  
a plurality of image content distribution splitter nodes (page 7, lines 13-19).;  
wherein when said main image content distributing apparatus is requested to  
distribute said image content, said main image content distributing apparatus selects  
said image content distribution splitter node and distributes said image content to said  
image content distribution splitter node and said image content is distributed from said  
image content distribution splitter node to said image content reproducing apparatus  
(plurality of intermediate routers and nodes present in an Internet distribution system;  
page 7, lines 13-19 and page 10, line 23-page 11, line 5).

As to claim 18, while Bar-el discloses image content providing system (page 7, lines 2-19), comprising:

an image content providing apparatus having an image content and having a function of providing said image content via stream distribution (Fig. 1; page 8, lines 4-18);

an advertisement image providing apparatus having an advertisement image to be inserted to said image content and having a function of providing said advertisement image via stream distribution to said image content providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

an image content reproducing apparatus having a function of reproducing said image content and said advertisement image received from said image content providing apparatus (page 8, lines 15-18);

wherein said image content providing apparatus has a function of inserting the advertisement image transmitted via stream distribution from said advertisement image providing apparatus at the position in said image content (page 14, line 24-page 16, line 21) and providing via stream distribution said image content and said advertisement image to said image content reproducing apparatus (Fig. 1-2; page 7, line 11-page 8, line 18), he fails to specifically disclose restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the

typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claims 32 and 34, Bar-el, Srinivasan and Zigmond disclose wherein said image content is a moving picture (page 8, lines 11-18).

As to claim 36, while Bar-el discloses an image providing method of providing an image from an image program providing apparatus to an image program reproducing apparatus (page 7, lines 2-19), said image providing method comprising the steps of:

requesting, via the stream distribution, distribution of said image from said image program reproducing apparatus to said image content program providing apparatus (page 7, lines 20-22);

transmitting, via stream distribution, said image to said image program reproducing apparatus (Fig. 1; page 8, lines 4-18) and during transmission detecting a position of inserting an advertisement image in said image at said image program providing apparatus (page 14, line 14-page 15, line 5);

requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image to said image program providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

selecting said advertisement image to be inserted into said image (page 11, line 14-page 12, line 9) and transmitting thereof by stream distribution to said image

program providing apparatus at said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

inserting said advertisement image transmitted to said image program providing apparatus at the position of inserting said advertisement image into said image (page 14, line 24-page 16, line 21); and

distributing, via stream distribution, the advertisement image, wherein the image program providing apparatus instructs a plurality of deputy image program providing apparatuses to distribute the image with the inserted advertisement image to said program reproducing apparatus (plurality of intermediate routers and nodes present in an Internet distribution system; page 7, lines 13-19 and page 10, line 23-page 11, line 5), he fails to specifically disclose restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claims 33 and 35, while Bar-el, Srinivasan and Zigmond disclose wherein said image content is video, they fail to specifically disclose wherein said video content is one of a movie, a drama and an animation.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide movies, dramas and an animation, which were all well

known and popular forms of video, for the typical benefit of providing viewers with the respective form of video content, such as a movie, drama or animation, that they desire.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include wherein said video content is one of a movie, a drama and an animation for the typical benefit of providing viewers with the respective form of video content, such as a movie, drama or animation, that they desire, in an interactive video distribution system.

As to claim 2, while Bar-el, Srinivasan and Zigmond disclose wherein when said image content is requested to distribute at said image content reproducing apparatus, said image content is selected and requested to distribute based on information for viewing said distributable image contents to be transmitted from said image content providing apparatus (page 7, line 20), they fail to specifically disclose a title list.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.



As to claim 20, while Bar-el discloses an image content providing apparatus for providing an image content via stream distribution (Fig. 1; page 8, lines 4-18), said image content providing apparatus comprising:

an image content database for storing said image content (Fig. 2; page 11, lines 20-23);

image providing means having a function of receiving an advertisement image via stream distribution (page 12, lines 3-9 and page 14, line 22-page 15, line 5), inserting the advertisement image at a position in said image content of said image database (page 14, line 24-page 16, line 21) and distributing thereof via stream distribution (Fig. 1-2; page 7, line 11-page 8, line 18), and

means having a function of forming information of viewing said image content stored to said image content database and providing said title list (means for user selection of an available video; page 11, lines 20-21), he fails to specifically disclose a title list, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the

user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a

maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 28, while Bar-el discloses a program storage medium stored with an image content providing program which is a program storage medium stored with an image content providing program for providing an image content (Fig. 2; page 11, lines 20-23), said program storage medium comprising:

image providing means having a function of receiving an advertisement image via stream distribution (page 12, lines 3-9 and page 14, line 22-page 15, line 5), inserting the advertisement image at a position in said image content of said image database (page 14, line 24-page 16, line 21) and distributing of the advertisement image via stream distribution (Fig. 1-2; page 7, line 11-page 8, line 18),

means having a function of forming information of viewing said image content stored to said image content database and providing said title list (means for user selection of an available video; page 11, lines 20-21), he fails to specifically disclose a title list, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for

the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as

taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 10, while Bar-el discloses an image content providing method of providing an image content from an image content providing apparatus to an image content reproducing apparatus (page 7, lines 2-19), said image content providing method comprising the steps of:

requesting, via the stream distribution, to provide said image content from said image content reproducing apparatus to said image content providing apparatus (page 7, lines 20-22);

providing said requested image content from said image content providing apparatus to said image content reproducing apparatus (Fig. 1; page 8, lines 4-18);

detecting at said image content reproducing apparatus a position of inserting an advertisement image in said image content when said image content is reproduced at said image content reproducing apparatus (page 14, line 14-page 15, line 5 and page 17, line 3-page 18, line 5);

requesting, via stream distribution, to distribute said advertisement image from said image content reproducing apparatus to an advertisement image providing apparatus having an advertisement image to be inserted (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

selecting said advertisement image to be inserted into said image content (page 11, line 14-page 12, line 9) and distributing thereby via stream distribution to said image content reproducing apparatus at said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5 and page 17, line 3-page 18, line 5); and

reproducing said advertisement image when the position of inserting said distributed advertisement image is reached in reproducing said image content at said image content reproducing apparatus (page 14, line 24-page 16, line 21 and page 17, line 3-page 18, line 5), he fails to specifically disclose downloading the requested image content in its entirety prior to reproducing the image content and an advertising insertion condition set by an image content owner.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) for inserting targeted advertisements into a VOD presentation (paragraphs 202-204), where the viewer will select and fully download the VOD content in advance (Fig. 18, downloading vs. streaming; paragraph 236) to allow the VOD content to be reproduced at a later time (paragraph 236) for the typical benefit of providing the viewer with more options and flexibility on how to receive and view their desired content (paragraph 236).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include downloading the requested image content in its entirety prior to reproducing the image content, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 12, Bar-el, Srinivasan and Zigmond disclose wherein the position of said image content for inserting said advertisement image is detected at said image content reproducing apparatus based on advertisement inserting condition data having an advertisement image inserting position condition for designating the position of inserting said advertisement image and an advertisement image selecting condition for

designating a category of said advertisement image capable of being inserted to said image content (column 14, lines 14-21 and column 11, lines 14-19).

As to claim 13, Bar-el, Srinivasan and Zigmond disclose wherein said advertisement inserting condition data includes an advertisement image reproducing condition for designating a maximum period of time for reproducing said advertisement image when said advertisement image is inserted to said image content (page 14, lines 14-21).

As to claim 14, Bar-el, Srinivasan and Zigmond disclose wherein when said advertisement image is requested to distribute at said image content providing apparatus, said advertisement inserting condition data is transmitted to said advertisement image providing apparatus (page 11, lines 9-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said advertisement inserting condition data (page 11, lines 9-19).

As to claim 15, Bar-el, Srinivasan and Zigmond disclose wherein when said advertisement image is requested to distribute at said image content providing apparatus, said viewer information is transmitted to said advertisement image providing apparatus (page 11, lines 6-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based



on said viewer information (page 11, lines 6-19).

As to claim 11, while Bar-el, Srinivasan and Zigmond disclose wherein when said image content is requested to distribute at said image content reproducing apparatus, said image content is selected and requested to distribute based on information for viewing said distributable image contents to be transmitted from said image content providing apparatus (page 7, line 20), they fail to specifically disclose a title list.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

As to claim 16, Bar-el, Srinivasan and Zigmond disclose wherein said image content is provided by said image content providing apparatus by subjecting said image content to download distribution to said image content reproducing apparatus (see Srinivasan at paragraph 236).

As to claims 19, 22 and 30, see the rejection of claim 10 above.

As to claim 37, see the rejection of claim 10 and 16 above.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-el, Srinivasan and Zigmond and further in view of Hite.

As to claim 17, while Bar-el, Srinivasan and Zigmond disclose transmitting and storing the image content to the image content reproducing apparatus prior to reproduction (see Srinivasan at paragraph 236), they fail to specifically disclose wherein said image content is provided by said image content providing means by transmitting an information recording medium recorded with said image content to said image content reproducing apparatus.

In an analogous art, Hite discloses system for providing image content and advertisement images (column 7) where the content is provided by transmitting an information recording medium recorded with said content to said image content reproducing apparatus (column 9, lines 15-42) for the typical benefit of providing viewers with additional means to receive programming, which would reduce system bandwidth and could be provided during times that the transmission network is malfunctioning.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include wherein said image content is provided by said image content providing means by transmitting an information recording medium recorded with said image content to said

image content reproducing apparatus, as taught in combination with Hite, for the typical benefit of providing viewers with additional means to receive programming, which would reduce system bandwidth and could be provided during times that the transmission network is malfunctioning.

### ***Conclusion***

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on \_\_\_\_\_.  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

### **Certificate of Transmission**

Application/Control Number:  
09/878,581  
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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. ( ) \_\_\_\_\_ - \_\_\_\_\_ on \_\_\_\_\_.  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/  
Primary Examiner, Art Unit 2424

JS